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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,597	03/13/2001	Carolyn W. Hall	HALL-101	4573

7590  
Robert K. Tendler  
65 Atlantic Avenue  
Boston, MA 02110

05/30/2003

EXAMINER

CHRISTMAN, KATHLEEN M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 05/30/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/808,597	<b>Applicant(s)</b> HALL ET AL.	
	<b>Examiner</b> Kathleen M Christman	<b>Art Unit</b> 3713	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 02 April 2003.

2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1,3-5 and 7-24 is/are pending in the application.

    4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1, 3-5 and 7-24 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All    b) ☐ Some \*    c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    \* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

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### DETAILED ACTION

In response to the amendment filed 04/02/2003, claims 2 and 6 have been cancelled, claims 1, 3-5, and 7-24 are pending.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1, 3-5, and 7-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation of "expecting receipt of a mini-lessons" in claim 1 is unclear. There is no method step that recites a mini-lesson is being sent to a user, and thus the user may receive such mini-lesson. It is inferred that this limitation refers to the learning task that is transmitted to the user, however it is unclear as to whether this is applicant's intention. Further the use of the plural form (i.e. mini-lessons) with the indefinite article "a" is unclear. Claims <sup>3-5</sup>~~2-5~~ and 7-20 are rejected for their inclusion of the above through their dependencies. Further, claim 15 recites the limitation "the activity". There is insufficient antecedent basis for this limitation in the claim. Further it is noted that claims 7-9, are improperly dependent upon cancelled base claims. For purposes of this action, the examiner has treated claims 7 and 9 as dependent upon claim 1, claim 8 depending from claim 7.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-5, and 7-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fargano (US 6257896 B1). Fargano teaches a method for transmitting questions for a user that can be interpreted as the method for increasing retention in the learning process as claimed. Fargano teaches a central server which includes a plurality of challenges that may be transmitted to the user, see Figure 6. The step of automatically transmitting to an individual learning tasks to be performed multiple times during the day from an Internet Site, thus to provide the individual with an active learning experience pushed from the Internet site at pre-selected times during the day at which the individual is expecting receipt of a mini-lesson, as in claim 1, is taught in col. 1: 36-40, col. 5: 9-10 and further in col. 5: 14-18. Receiving responses from the user and transmitting the responses back over the Internet to the Internet Site, as in claim 3, is taught at col. 3: 10. Altering the individual learning tasks from the Internet site responsive to the responses of the individual to prior learning tasks from the Internet site, claim 4, equates to the adaptive system as taught at col. 2: 45-47. The learning tasks being time limited so as not to interfere with the normal tasks of the individual (claim 5) and the automatic transmission being at a pace so as not to disrupt the individual during his workday (claim 10), are taught at col. 4: 59-61 and col. 3: 35. The limitations of claims 7 and 8 are taught by the example given at col. 7: 14-22. Figure 4 teaches receipt of the learning task being indicated by the response of the individual to the learning task, as in claim 12. The learning task including experiential learning in which the individual is prompted to respond with some action, as in claim 11, is equivalent to those types of challenges taught at col. 7: 15-22. Improving competency in the work place (claim 13) is deemed to be identical to the "skills building" of the Fargano patent.

It is noted that Fargano does not specifically state that the tasks are transmitted from an Internet site (claim 1 and its dependents). However, the Internet site is deemed to be substantially identical to the server system underlying the Fargano method. As an Internet Site does not actually have the capability to transmit data, but rather the underlying software and hardware functionalities associated with the site.

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Fargano further does not specifically disclose that the "communication device" is a computer or a personal digital assistant (PDA). Fargano gives examples of the communication device being e-mail, voice mail, a cellular phone, or a pager. E-mail is well known to be receivable of PDAs and personal computers. As such, these devices are deemed to be functional equivalents.

Regarding claims 14-20, Fargano does not teach that the tasks are directed to an athletic activity (claim 14), namely golf (claim 15), empower women to react to specific workplace encounters with positive results (claim 16), improve the response of an individual to health related issues (claim 17), namely weight (claim 18), addiction (claim 19) and the taking of medication (claim 20). It is the examiner's position that the particular type of educational content transmitted to the user is a non-patentably distinct feature. Each of the areas above are well-known areas of education, and as such it would be obvious to one of ordinary skill in the art to the invention of Fargano to adapt the tasks to be directed to any of the above areas.

Claims 21-25 correspond to a system of substantially similar scope as claims 1, 3, and 4 above and are rejected for the same reasons. Where the "response entry device, of claim 22 equates to the "communication device" which the user of the Fargano invention is provided.

### ***Response to Arguments***

3. Applicant's arguments filed 04/02/2003 have been fully considered but they are not persuasive. Applicant argues that Fargano fails to teach a that the mini-lessons or "challenges" are sent to the user at pre-selected times during the day at which the individual is expecting receipt of a mini-lessons." In support of this argument applicant has cited the sections of Fargano that teach that the challenge is sent to the user autonomously, and that the statement at col 4: 24-32 which states, in accordance with the present invention, the challenge is sent autonomously. This means that the subject must always be ready for challenges, because one may arrive at any time." However, the applicant has taken this citation out of context. Starting at col. 4: 25, Fargano reads:

"After the telecommunications channel is selected, based on any of a number of different criteria, a challenge is autonomously sent over the selected channel to the subject at block 14. In

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accordance with the present invention, the challenge is sent autonomously. This means that the subject must always be ready for challenges, because one may arrive at any time."

As one can see the challenge is sent based on a number of criteria. One such criteria is described starting at col. 4: 62:

"With reference to FIG. 2, in an embodiment of the present invention that utilizes a challenge schedule, a method of establishing a challenge schedule is generally indicated at 30. At block 32, at least one challenge schedule criterion is established. At block 34, the challenge schedule is sufficiently established such that, once fully realized, the schedule meets the at least one challenge schedule criteria. That is, depending on the criteria to be met by the schedule, it may not be necessary to firmly establish a fixed schedule. On the other hand, it may be necessary to lay out some guidelines (criteria) for the sending of challenges, while leaving the significant details, such as the particular times and channels when a challenge is sent to be determined on the fly. **That is, in one extreme case, the challenges may have no schedule and be randomly sent to random subjects over random communications channels. On the other extreme, the challenge schedule may be predetermined and precisely followed.** In between these two extremes, criteria may be established, with the schedule being sufficiently established so that the criteria are met, however, the schedule need not be completely and rigidly defined ahead of time. For example, each day may have a list of subjects to be challenged, but the communication channel and challenge to be sent, as well as the time for sending, may be a random time during the day."

Clearly although the preferred method of delivering the challenges may be to surprise the user, Fargano clearly teaches that the challenges can be delivered on a predetermined schedule which is precisely followed. It is clear from this that a user would be expecting a challenge at a predetermined time. Thus the Fargano invention does not rely on surprise or teach away from the claimed subject matter.

Applicant has further argued that the lack of the exact phrase "the Internet" teaches a clear difference between applicant's claimed invention and that of Fargano. The Internet site is deemed to be substantially identical to the server system underlying the Fargano method. As an Internet Site does not actually have the capability to transmit data, but rather the underlying software and hardware functionalities associated with the site. The allegation that the Internet "simplifies" the task of delivering mini-lessons is unsupported. Further the Internet is defined a "an electronic communications network that

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connects computer networks and organizational computer facilities around the world" (Merriam Webster Collegiate Dictionary, 10<sup>th</sup> edition). Thus the Internet qualifies as a telecommunication channel as they are described in Fargano.

**Conclusion**

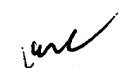
4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

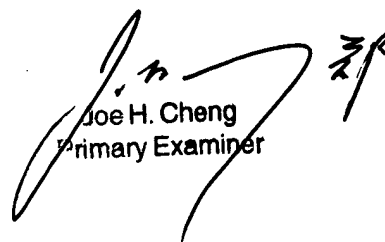
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (703) 308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
Kathleen M. Christman  
May 22, 2003

  
Joe H. Cheng  
Primary Examiner